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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,154

07/15/2003

David J. Talaber

R0372-00101

8486

7590

09/08/2006

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EXAMINER

RAMANA, ANURADHA

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/620,154	Applicant(s) TALABER ET AL.	
	Examiner Anu Ramana	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☒ Claim(s) 1-28, 51, 54-58 and 74-88 is/are allowed.
 6) ☒ Claim(s) 29-39, 41-50, 52, 53, 59-71, 73 and 89-105 is/are rejected.
 7) ☒ Claim(s) 40 and 72 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/10/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. At least one box in PTO/SB/51 must be checked.

This application is also objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action. It is unclear whether Mr. David J. Talaber is an officer of the company as required. See MPEP 324 V. For this reason, the Consent Form is deemed to be deficient.

Claim Objections

Claim 39 is objected to because it is unclear which claim it depends from. For purposes of examination, it has been assumed to depend on claim 37. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 52-53, 59 and 103-105 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 52, line 19, "the stopping member" lacks antecedent basis.

In claim 59, lines 22 and lines 23-24, "the second opening" and "the stopping member" lack antecedent basis.

In claim 103, line 2, "the biased stopping member" lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29-39, 41-48, 50-51, 60-71, 73 and 89-105 are rejected under 35 U.S.C. 102(e) as being anticipated by Errico et al. (US 5,876,402).

Errico et al. disclose an attachment component or stabilizing element 100 including: a bore 111 having a first bore passageway portion and a second bore passageway portion with at least one smaller transverse dimension than the first bore passageway portion; a stopping member 180 having a biased stopping surface; and a third bore passageway portion between the biased stopping surface and the second bore passageway portion having a surface configured to conform to the enlarged portion or head of the securing component (Fig. 6, col. 5, lines 41-67 and col. 6, lines 1-55). See marked up Figure 6 from Errico et al. below.

Regarding claim 45, a fixation element such as a plate conforms to the surface of the underlying bone and thus could have a curved surface.

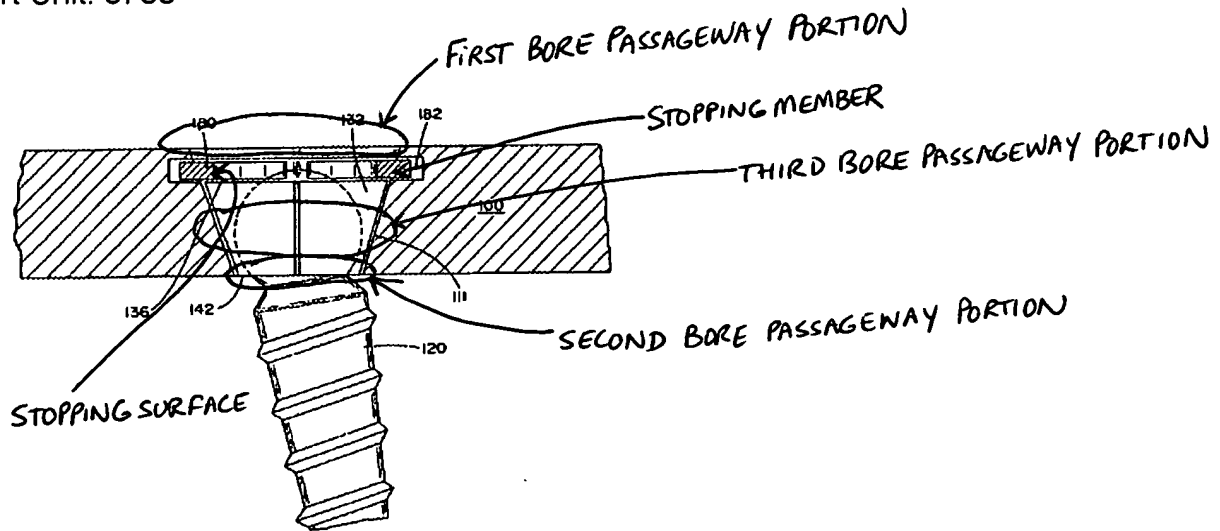
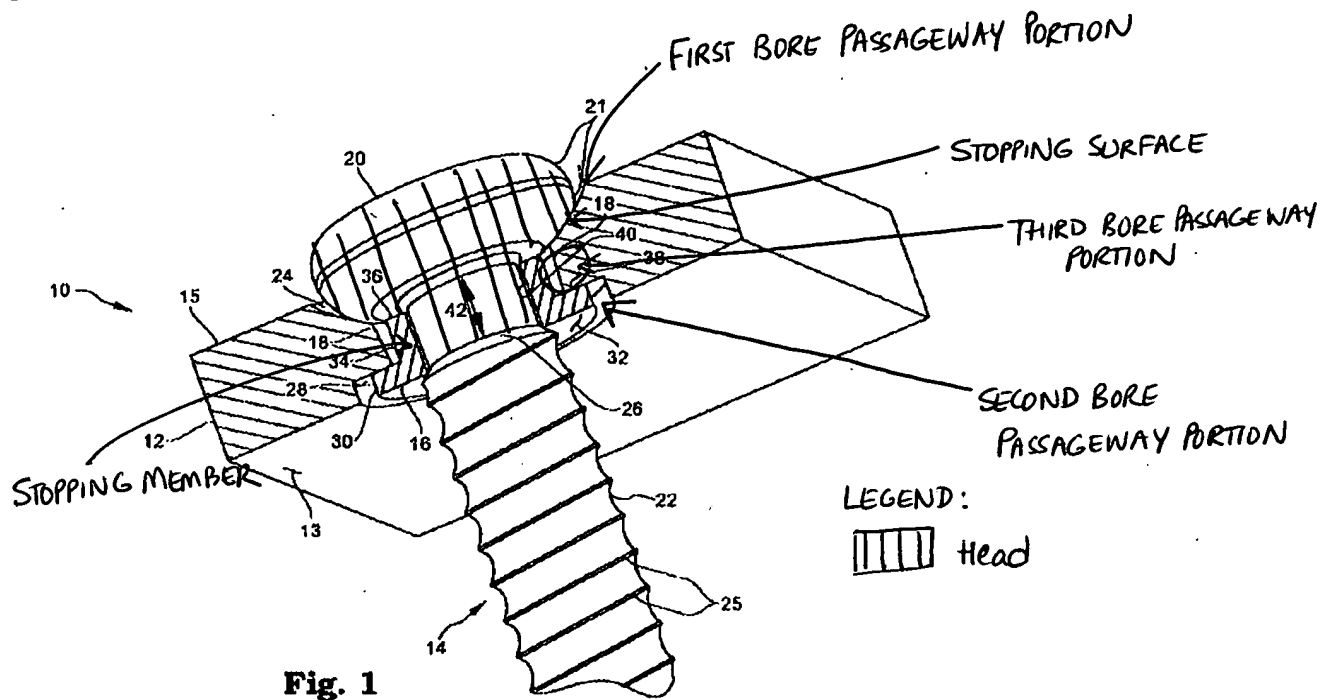


FIG. 6

Regarding claims 94 and 95, it is noted that resilient stopping member 180 deflects radially as well as longitudinally due to its resilient nature.

Claims 60-67, 69-71, 73-79 and 89-95 are rejected under 35 U.S.C. 102(b) as being anticipated by Estes (US 5,578,034).

Estes discloses an attachment component or stabilizing element 12 including: a bore 18 configured to receive a fastening element or securing member 14, the bore having a first passageway portion and a second passageway portion, the second passageway portion having a smaller transverse dimension than a transverse dimension of the first passageway portion; a stopping surface which reduces a transverse configuration of the first passageway portion; a stopping member 16 defining a reversibly expandable passageway; and a third bore passageway portion between the stopping surface and the second bore passageway portion wherein the third bore passageway portion has a surface configured to conform at least in part to an enlarged portion of securing member 14 (Fig. 1, col. 4, lines 36-67, col. 5 and col. 6, lines 1-46). See marked up Fig. 1 from Estes below.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errico et al. (US 5,876,402).

Errico et al. disclose all elements of the claimed invention except for the stopping member 180 being made of titanium or a superelastic material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed stopping member 180 of titanium or a superelastic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use,

herein enhanced mechanical properties including fatigue endurance, as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claim 59 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 40 and 72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-28, 51, 54-58 and 74-88 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

September 3, 2006

Anuradha Ramana


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER